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### REMARKS

In this Response, Applicants traverse the Examiner's rejections. Silence with regard to any of the Examiner's rejections should not be construed as acquiescence to any of the rejections. Specifically, silence with regard to any of the rejections of the dependent claims that depend from an independent claim considered by Applicants to be allowable based on the Remarks provided herein should not be construed as acquiescence to any of the rejections. Rather, silence should be construed as recognition by the Applicants that the previously lodged rejections are moot based on the Remarks submitted by the Applicants relative to the independent claim from which the dependent claims depend. Applicants reserve the option to further prosecute the same or similar claims in the instant or a subsequent application. Claims 1-56 are pending in the instant application.

#### Request for Second, Non-Final Office Action

On August 26, 2003, Applicants submitted a Request for Continued Examination (RCE) that included a Response having claim amendments and a detailed discussion of the Kirby reference. On October 3, 2003, the Examiner issued an Office Action, for which this document is in Response. Such October 3, 2003 Office Action is a "cut and paste" of the prior Office Action of February 24, 2003, and does not include any acknowledgement of the Applicants' claim amendments and/or Remarks. Applicants respectfully remind the Examiner of 37 CFR 1.104(c)(2), and request that the present claims and present Remarks be considered, and addressed accordingly, in accordance with such provision. Applicants are sincerely interested in working together with the Examiner in furthering prosecution of the present case, and Applicants believe in the allowability of the present claims; however, the present Office Action, which fails to address any of the Applicants' amendments and/or claims, also fails to provide the Applicants with an ability to address the Examiner's concerns. Applicants thus respectfully request a second, non-final Office Action that addresses the prior claim amendments and the Remarks included herein.

#### Office Action, ¶¶ 1 and 2

The Examiner rejected claims 1-56 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,047,179 to Kirby.

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*Claims 1-11*

Applicants' independent claim 1 is directed to a system for allowing a subscriber to a prepaid communication service to roam between different service markets. Among other things, Applicants' independent claim 1 includes a location register capable of: *determining whether a prepaid platform is associated with a market for a mobile switching center and modifying a subscriber profile based on whether a prepaid platform is associated with the market.*

The Examiner stated that Kirby discloses "upon a mobile terminal registration with a mobile switching center, the MSC's class of market is identified whether it is a subscription (pre-paid platform association) or a non-subscription (no pre-paid platform association) service providers. If the mobile switching center is a subscription service providers, the national hub will route all calls through the pre-paid platform associated with the service provider (col. 12/ln. 42-67) and if the mobile switching center is a non-subscription service providers, the national service hub alters certain parameters of the subscriber's profile (col. 18/ln. 39-67) and route the call to a toll-free number (hot-line number)."

Applicants respectfully disagree with the Examiner's characterization of Kirby and its teachings. Applicants have made a careful reading of Kirby. Kirby teaches the following:

1. There are "subscription" networks and, with reference to Kirby Figure 1, such subscription networks include an IMT, such as the IMT 50 in home network B and the IMT 30 in "subscription service provider A's network." (Kirby Column 13, lines 42-46).

2. There is a "national service hub" 70 that also includes an IMT 75. (Kirby Column 13, lines 46-50). At Column 11, lines 13-23, Kirby teaches: "The national debit platform 72 typically is a facility for keeping track of debit units and the prepaid services to be accorded to the debit units. This service hub 70 and the debit platform 72 are defined as "national" because *they may not be associated with any particular wireless network, and in fact, may serve more than one wireless network. Typically, a service provider that has only basic call routing or call processing functions may engage the facilities of a national service hub 70. Further, a service provider that does not have a debit platform may engage the facilities of a national debit platform.*" (emphasis provided by Applicants).

3. The IMTs in the various "subscriber" networks allow for the exchange of information between networks that may have otherwise disparate protocols, using *standard inter-network*

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*communications* rather than the voice channels that can be overloaded (Kirby Column 5, lines 36-40, and Column 3, lines 17-24).

4. Based on 1-3 above, subscriber visitor networks (i.e., those networks having an IMT) such as network A can communicate with subscriber home networks such as network B using these *standard inter-network communications* between the respective IMTs. Accordingly, call registration can proceed between a subscriber visitor network (A) and a subscriber home network (B) without the service of the national hub (Kirby Column 18, lines 14-38, "registration" between networks A and B; and, Column 19, lines 1-25); however, call authorization and processing by network A is based on whether network A includes a debit platform (Column 19, line 26-28). As described in Columns 19-22, when network A includes a debit platform as shown in Figure 1, the call can be authorized and processed by network A entirely via *inter-network communications* without the service of the national hub. Nowhere in the description of the cited Kirby passages, or in the remainder of the Kirby specification, are the communications between subscriber network A and B *ever* described as using the national hub. It is therefore based on the underlined section of paragraph "2" above, that when a subscriber network such as network A does not include its own debit platform 26, such subscriber network may enlist the debit platform services of national hub for call authorization and processing, and it is also deduced that this is the meaning of the *dotted line* between network A and national hub in Kirby Figure 1, as such communication is not relevant for the depicted embodiment in which network A *does* include a debit platform.

5. Also based on 1-3 above, for Kirby's system to gain additional usage of non-subscriber networks such as network C that do not include a IMT, Kirby provides the national hub to allow these non-subscriber networks to take advantage of such IMT services utilizing the national hub's IMT. Indeed, unlike subscriber network A that can perform unit registration *without the national hub* (Kirby Column 18, lines 14-38), non-subscriber network C cannot perform even basic registration without an IMT, and accordingly, must use the national hub IMT. The registration process via national hub is thus different, as provided in contrast to Kirby Column 18, lines 14-38 cited above, to Kirby Column 18, lines 39-67 for non-subscribers.

Particularly, Applicants direct the Examiner to the main difference between subscriber network (A) registration that does not include the national hub (Kirby Column 18, lines 14-38),

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and non-subscriber network registration that does include the national hub (Kirby Column 18, lines 39-67):

Subscriber Networks: "This response message may include information that alerts *the visited network 20* that the roamer is using a debit unit." (Kirby Column 18, lines 27-29)(emphasis provided by Applicants); versus,

Non-Subscriber Networks: "This response message may include information that alerts *the hub 70* that the roamer is using a debit unit." (Kirby Column 19, lines 51-53)(emphasis provided by Applicants).

There is thus a clear distinction between communications of Kirby's subscriber networks and non-subscriber networks: Kirby's subscriber networks communicate directly via Kirby's IMTs using *standard inter-network communications*, and a national hub is thus not necessary. Alternatively, Kirby's non-subscriber networks do not have an IMT, and hence, effectively "borrow" the IMT of the national hub to participate in Kirby's system, where Kirby's *self-serving* national hub modifies the unit (e.g., TCAP parameters) in the non-subscriber network *during registration* to direct call processing through the national hub. Such unit modification is patently unavailable when subscriber networks are involved, as the national hub is not involved in registration of subscriber units. The national hub therefore does not make determinations about a specific network, but rather, responds to requests from networks accordingly

In contrast to Examiner's interpretation, nowhere does the national hub make a determination of whether a given network includes a prepaid platform, and modify a profile based on this determination. As previously provided herein, Kirby's national hub merely responds to requests for services: if a subscriber network requests call processing services, the national hub is available to provide them; and, in cases on non-subscriber networks, the national hub *forces* call processing through the national hub via Response message modification of TCAP parameters (Col. 18., lines 57-61), *regardless of whether the non-subscriber network includes a debit platform*.

Stated differently, the Kirby modifications are Response message modifications of TCAP parameters and are only performed on non-subscriber network requests during a registration process that occurs only for units in non-subscriber networks, regardless of whether such non-subscriber network includes a debit platform. Because subscriber networks do not use the

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national hub for registration, there is no national hub Response message to modify a TCAP parameter. Accordingly, *Kirby is based on whether the network is a subscriber network and, nowhere does Kirby ever teach that the national hub or any other component(s) does any determining whether a prepaid platform is associated with a market for a mobile switching center and modifying a subscriber profile based on whether a prepaid platform is associated with the market, all as claimed by Applicants.*

As the Examiner knows, to establish a prima facie rejection under 35 U.S.C. § 102(e), the Examiner must show that all features of Applicants' claims are satisfied by the cited prior art reference. As provided herein, Kirby does not teach all features of Applicants' independent claim 1. The Examiner thus fails to satisfy the requirements of 35 U.S.C. § 102(e).

Applicants thus traverse the Examiner's rejection of independent claim 1 and consider independent claim 1 to be allowable. Since dependent claims 2-11 depend from allowable independent claim 1, Applicants consider dependent claims 2-11 to also be allowable as depending from an allowable base claim.

#### *Claims 12-56*

Applicant's independent claims 12, 21, 28, 33, 38, 43, and 51 include features similar to those presented in claim 1, which includes *determining whether a prepaid platform is associated with a market for the mobile switching center and modifying a subscriber profile based on whether a prepaid platform is associated with the market.*

As previously provided herein with respect to claim 1, the Examiner fails to show either of these claimed features in Kirby. Because Kirby does not teach either of these claimed features, the Examiner fails to provide a prima facie rejection under 35 U.S.C. § 102(e).

Applicants thus traverse Examiner's rejection of independent claims 12, 21, 28, 33, 38, 43, and 51 based on 35 U.S.C. § 102(e) and consider independent claims 12, 21, 28, 33, 38, 43, and 51 to be allowable. Since dependent claims 13-20, 22-27, 29-32, 34-37, 39-42, 44-50, and 52-56 depend from allowable independent claims 12, 21, 28, 33, 38, 43, and 51, respectively, Applicants consider dependent claims 13-20, 22-27, 29-32, 34-37, 39-42, 44-50, and 52-56 to also be allowable as depending from an allowable base claim.

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### CONCLUSION

Applicants consider the Response herein to be fully responsive to the Office Action. Based on the foregoing Remarks, Applicants respectfully submit that this application is in condition for allowance. Accordingly, Applicants request allowance. Applicants invite the Examiner to contact the Applicants' undersigned Attorney if any issues are deemed to remain prior to allowance.

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